

REMARKS

The undersigned thanks Examiner Egan for the in-person interview on August 31, 2004.

As the undersigned indicated at the interview he would do, submitted herewith is a Terminal Disclaimer for overcoming the provisional double patenting rejection based on copending application Serial No. 10/311,736 in view of Stough et al.

Also as discussed at the interview, the claims have been amended to recite that the backing consists of a uniform material of planar construction.

The typographical errors in claims 23 and 27 have been corrected. In claim 1, "overlying" has been replaced with more definite terminology, "in contact with." Recitations of "a non-adhering central strip" have been deleted from claim 19 and, likewise, claim 12 has been canceled. The recitation of "adhesive" in claims 1 and 19 has been made more definite, namely, "pressure-sensitive adhesive."

Claim 1-16 and 19-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Stough et al. (5,711,124) in view of Hibler (6,001,201) and Tuoriniemi (6,444,307) and claims 17, 18, 33 and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Stough et al. in view of Hibler and Tuoriniemi and further in view of Avery (2,373,092), Blok et al. (6,177,163) and Samuelson (5,736,001).

The Examiner notes that “Stough et al. fail to teach the protective layers comprising multiple slits and the tape being folded upon itself in a transverse direction along a slit.” It should also be noted, however, that Stough et al. have no need for, and explicitly wish to avoid use of, a protective layer on the pressure-sensitive adhesive coating which is to adhere the tape to joint surfaces. Stough et al use a release coating. The undersigned is aware that the Examiner might try to show that the prior art recognizes equivalence of a release coating and a protective layer. What is equivalent, however, in one context may not be equivalent in another context. In fact, it is the expressly stated objective of Stough et al. to avoid a protective layer (known also by other terms, such as “release backing” or “release liner”). Thus, Stough et al. state: “What is needed is a tape for drywall installation which may be applied in a single step, without the need for removal of a release backing.” Thus, Stough et al. expressly teach away from the use of a release backing on a pressure-sensitive adhesive coating that is to adhere the tape to a joint. It is, therefore, respectfully submitted that to combine Stough et al. with any prior art, such as Hibler, in which a release liner 21 covering the pressure-sensitive adhesive coating which is to adhere the tape to surfaces to which the tape is applied and, thus, for which removal of the release liner is required as the tape is being applied, contrary to the core objective of Stough et al., constitutes an impermissible attempt to reconstruct the invention with the benefit of hindsight.

Moreover, in Hibler, “the tape . . . is formed from polymeric material formed into a pair of sides with an interconnecting hinge, said sides formed from a relatively stiff polymeric material compared to said hinge which is formed from a relatively flexible and elastic polymeric material compared to said sides, said hinge being arcuate in shape, said tape having a front surface and a rear surface which is coated with a pressure sensitive adhesive.” (Col. 2, lines 13-21.) Unlike the presently claimed invention, the backing of Hibler does not consists of a uniform material of planar construction because the hinge part of the backing consist of a material different from the rest of the backing and, moreover, is arcuate. Furthermore, unlike the presently claimed invention, Hibler’s tape has no slit. Hibler discloses “a scored release liner” (Col. 4, line 30). A “slit” is a long narrow cut or opening.” *Webster’s Third New International Dictionary*, 2002. On the other hand “scored” means “marked with lines or grooves.” Again, *Webster’s Third New International Dictionary*, 2002, the dictionary which has been most often cited by the Federal Circuit.

Tuoriniemi’s tape, unlike the presently claimed invention, has no covering film on and strippable away from a pressure-sensitive adhesive layer on the backing. Tuoriniemi makes no use of a covering film (release liner) on a pressure-sensitive adhesive layer so it seems quite unrelated to Hibler and to the present invention. Moreover, if one of ordinary skill in the art were to fold Hibler’s tape before winding it into a roll, that person would fold the tape so that the release

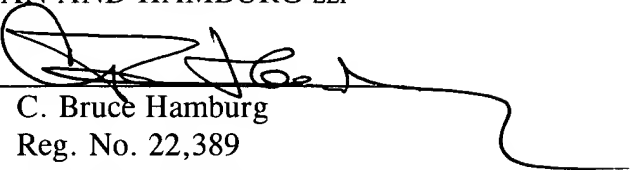
liner was against itself. A roll of Hibler's tape folded so that the backing was against itself, which the Examiner suggests would have been obvious in view of Tuoriniemi, would be inconvenient to use for its intended purpose, as it would then have to be unfolded 180°. Moreover, because Tuoriniemi does not disclose the use of a release liner nor is there any reason why one of ordinary skill in the art would wish to use a release liner in trying to implement Tuoriniemi's invention, it is immaterial that, in the abstract or in some other context, the Examiner may allege equivalence of a release liner and a release coating. One of ordinary skill in the art would not wish to complicate Tuoriniemi's invention by trying to replace the release coating with a release liner. It is respectfully submitted that, again, the Examiner is indulging in an attempt to reconstruct the invention with the benefit of hindsight, which is impermissible.

Applicant respectfully request a three month extension of time for responding to the Office Action. Please charge the fee of \$980 for the extension of time to Deposit Account No. 10-1250. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,

JORDAN AND HAMBURG LLP

By


C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340